



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.      | CONFIRMATION NO. |
|-----------------|-------------|----------------------|--------------------------|------------------|
| 09/522,743      | 03/10/2000  | Alan D. Eyre         | NTL-3.2118/3229(11513SC) | 4725             |

26345 7590 09/16/2003

GIBBONS, DEL DEO, DOLAN, GRIFFINGER & VECCHIONE  
1 RIVERFRONT PLAZA  
NEWARK, NJ 07102-5497

EXAMINER

WEAVER, SCOTT LOUIS

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2645

DATE MAILED: 09/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/522,743

Applicant(s)

EYRE ET AL.

Examiner

Scott L. Weaver

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-97 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8, 10, 12-25, 27-39, 41-48, 52, 54, 56-69, 71-83, 85-90, 92 and 93 is/are rejected.
- 7) ☒ Claim(s) 5-7, 9, 11, 26, 40, 49-51, 53, 55, 70, 84 and 91 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 2645

## DETAILED ACTION

### *Claim Objections*

1. Claims 1, 14, 27, 45, 58, and 71 are objected to because of the following informalities: “CPE” as used in each listed independent claim needs to be provided a definition (i.e. CPE (customer premises equipment) as was used in each independent claim not listed so as to avoid confusion; confusion has already arisen as witnessed by the numerous misclassifications of the subject application. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2, 4, 12, 15, 27-37, 42-43, 46, 48, 56, 59, 71-81, 86-87, and 93-94 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 2, 4, 12, 15, 28, 43, 46, 48, 56, 59, 72, 87, and 94, reference is made to “said CPE” which causes confusion in that the two CPE’s were referred to directly as either ‘local’ or ‘remote’ in previous and subsequent claims.

Claims 27 and 71 recite the limitation “said voice message”. There is insufficient antecedent basis for this limitation in these claims.

Claims 42, 86 and 93 do not end with a “.” Period.

Art Unit: 2645

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, 8, 10, 12-13, 45-48, 52, 54, and 56-57 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Peterson et al. (#6,385,303).

Peterson clearly teaches those limitations in the claims noted above (via reference to col.4,ln.63-col.5,ln.3; col.14,ln.13-col.15,ln.21) and the clal announce feature described therein.

6. Claims 14-25, 27-36, 38-39, 41-44, 58-69, 71-80, 82-83, 85-90, and 92-93, as best understood due to the confusion noted above, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ensor et al. (#5,623,537).

Ensor (via col.2,ln.8-14 ; col.3,ln.1-11 ; col.4,ln.7-18 ; col.4,ln.33-50 ; col.9,ln.34-47 ; col.10,ln.38-50) teaches local CPE going off-hook to detect a CAS and using FSK to determine caller ID, Ensor further generates a page (voice message) to send to remote CPE and via use of caller identification, the remote CPE generates a voice message.

Art Unit: 2645

**Conclusion**

7. Claims 5-7, 9, 11, 26, 40, 49-51, 53, 55, 70, 84 and 91 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The prior art previously made of record in the parent application, but not made of record in this application by the applicant, and not relied upon is considered pertinent to applicant's disclosure.

9. Any response to this action should be mailed to:  
Commissioner of Patents and Trademarks  
Washington, D.C. 20231

or faxed to:

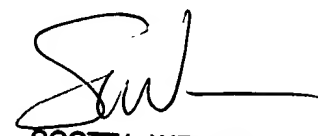
(703) 872-9314, (for formal communications intended for entry)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott L. Weaver whose telephone number is (703) 308-6974. The examiner can normally be reached on Monday through Friday from 8:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 2600 receptionist whose telephone number is (703) 305-4750 or 2600 Customer Service at 703-306-0377.

  
SCOTT L. WEAVER  
PRIMARY EXAMINER  
Art Unit 2645